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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,438	02/14/2002	Joel J. Gummeson	399429	8724
30954	7590	01/21/2004		
LATHROP & GAGE LC 2345 GRAND AVENUE SUITE 2800 KANSAS CITY, MO 64108				
EXAMINER MCCLENDON, SANZA L				
ART UNIT		PAPER NUMBER		
1711				

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,438

Applicant(s)

GUMMESON, JOEL J.

Examiner

Sanza L. McClendon

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. In response to the Amendment received on October 16, 2003, the examiner has carefully considered the amendments. The examiner acknowledges the cancellation of claims 6, 20, and 32 and the addition of claims 41-43. The amendment to the claims includes negative limitations and new matter therefore they will be rejected as follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. A waterfast ink jet composition is not supported by the specification. It is noted that applicant has support for a waterfast image, however a waterfast image would be the result of the cured ink composition and is not deemed to be an ink compositions.

The examiner is interpreting waterfast to mean, for instance that the image formed from said composition once cured does not run, bleed, or smear in the presence of or when treated with water. Therefore is unclear how an ink composition that comprises water as a required component can be waterfast. Clarification is requested.

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4. Claims 1-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The teaching "wherein said resin is not an epoxy resin is not disclosed in the instant disclosure. With regard to the "not an epoxy resin" limitation, negative limitations recited in claims, which do not appear in the specification as filed, introduced new concepts and violate description requirement of 35 USC 112—see *Ex parte Grasselli* or *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). The examiner refers applicant to the disclosure page 6, line 5 and page 10, paragraph 0030, which teaches that epoxide resins are useable in the instant ink composition. Appropriate action is required.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1, 5, 8-13, 15, 19, 22-25, 27, 31, 34-37 and 39-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiromichi (EP 0 953 613A2).

7. Claims 1-5, 7-19, 21-31, and 33-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanabe et al (EP 1 036 831 A1).

8. Claims 1-6, 8-15, 19-20, 22-32, and 34-43 rejected under 35 U.S.C. 102(b) as being anticipated by Laksin et al (WO 00/3440 A1).

Response to Arguments

9. Applicant's arguments filed October 16, 2003 have been fully considered but they are not persuasive. With respect to applicant's amendment to the preamble of the claims to include waterfast, it is unclear how a waterfast ink composition can comprise water—see rejections above.

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With respect to applicant's arguments regarding Hiromichi et al, the examiner disagrees. Hiromichi et al teaches a UV curable ink-jet composition comprising a polymerizable oligomer, water, a coloring agent, and a photoinitiator. Said polymerizable oligomers are soluble in water (i.e. dilutable) and comprise polyester oligomers as seen on pages 6 and 12-17 and the examples. Said polyester are deemed to anticipate applicant's UV curable resin as seen in claims 5, 19, 31, and newly added claims 41-43, wherein the improvement is deemed to be inherent to the composition.

With respect to applicant's arguments regarding Tanabe et al, examiner respectfully disagrees. Tanabe et al teaches an UV curable ink-jet ink composition comprising a colorant, a urethane acrylate oligomer, a reactive monomer, a photoinitiator, and an aqueous solvent that comprises water and a water-soluble organic solvent, along with methods of using. This appears to anticipate applicant's invention as claimed. It is noted that applicant does not require a reactive monomer as found in Tanabe et al, however applicant has used open language (i.e. comprising) in the composition claims, which is inclusive and fails to exclude the presence of other ingredients than those recited. Said urethane acrylate oligomer is deemed to anticipate applicant's UV curable resin as seen in claims 5, 19, 31, and newly added claims 41-43, wherein the improvement is deemed inherent to the composition and method.

With respect to applicant's arguments regarding Laksin et al, examiner respectfully disagrees. Laksin et al teaches UV curable ink compositions for use with ink-jet printing systems. Laksin et al teaches ink compositions comprising an epoxy resin, a water compatible hydroxyl compound, a colorant, a cationic photoinitiator, and water. In addition, Laksin et al teaches hybrid UV curable ink compositions comprising, in addition to the above components, a free-radically curable oligomer and/or polymer, diluent monomers, free-radical photoinitiators, wherein Laksin et al teaches acrylated epoxides, acrylated urethane, and acrylated polyester, which are deemed to anticipate the UV curable resins as seen in claims 5, 19, 31, and newly added claims 40-43, wherein the improvement is deemed to be inherent to the composition as described.

Therefore, the rejections of claims 1-43 as found above still stand, wherein the text portions not included in this Office action can be found in a prior Office action.

Conclusion

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10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

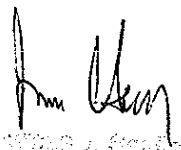
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0657.

Sanza L McClendon

Examiner

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SMc


Sanza L. McClendon
Supervisory Patent Examiner
Art Unit 1711